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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,228	02/22/2005	Hachiro Nakanishi	TAN-349	7189

62479 7590 08/17/2006

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/525,228		NAKANISHI ET AL.	
	Examiner		Art Unit	
	Anthony J. Green		1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/06/05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Amendment

1. The preliminary amendment submitted on 22 February 2005 has been entered. This amendment however is confusing as it recites 2 different claims numbered 15 (one that is represented and one that is canceled). Accordingly it is unclear as to exactly what claims are pending. Further applicant is reminded to use proper parenthetical expressions in the claims. That phrase "Re-presented formerly second claim" is not proper.

Specification

2. The disclosure is objected to because of the following informalities: In the specification the section entitled "Brief Captions of Drawings" should be changed to:
-- Brief Description Of The Drawings --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant fails to adequately describe the particle size encompassed by the phrase "nanometer size fine particles" as the specification does not recite the sizes encompassed by the specification. Is applicant intending this phrase to mean 100 nanometer or less or does applicant intend the phrase to represent 1 nanometer? Exactly what size is encompassed by the phrase? Clarification is requested.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrases "high concentrated" and "poor solvent" are vague and indefinite as the terms "high" and "poor" are relative terms. The phrase "the obtained pigment solution" lacks proper antecedent basis. It is unclear as to what the phrase "which is compatible with said solvent and is poor solvent to the pigment" refers to. That is what is compatible with said solvent and what is poor solvent? Clarification is requested.

In claims 4-6 the phrase "at least the one" is not proper Markush terminology.

In claims 7-10 it is unclear as to what is meant by the phrase "these two or more solvents".

In claims 11-12 it is unclear as to what is meant by the phrase "using solvent". What is it used as or how is it used? The phrase "containing said solvents more than 50 volume% as a solvent for the organic solvent" is confusing. It is unclear as to what is meant by this phrase and it is unclear as to which solvent is being referred to. Is it the amide organic solvent or the poor solvent? Clarification is requested. The phrase "at least the one" is not proper Markush terminology.

In claims 13-17 the phrases "the preparation of solution", "the condition", "the prepared high concentrated organic pigment solution of 0.5 mmol/L to 100 mmol/L", and "the lowest temperature of liquid state" lack proper antecedent basis.

Information Disclosure Statement

7. The prior art submitted by the applicant has been considered however it is not seen to teach and/or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Anthony J. Green". The signature is fluid and cursive, with the first name "Anthony" being more prominent.

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
August 6, 2006